

REMARKS

Introduction to restriction requirement

The Examiner has restricted the pending claims to three inventions: Group I, encompassing claims 1-7 and 13-19; Group II, encompassing claims 8-12; and, Group III, encompassing claims 20-24. Applicant respectfully but emphatically traverses the restriction, and strongly contends that the restriction is wholly improper. Applicant is prepared to file a petition with the Director should the Examiner not withdraw this restriction requirement.

First reason why the restriction requirement is improper

The *sine qua non* of restriction requirements is to prevent the Examiner from being subjected to an undue burden as a result of multiple inventions being claimed, which would force the Examiner to conduct multiple searches in separate fields of search. As the Examiner himself notes, “each Group require[es] a separate field of search” (restriction requirement, p. 3, para. 5). Applicant disagrees that each Group requires a separate field of search, but notes that *even if each Group did require a separate field of search, a search has already been performed!* Note that the Examiner has already performed a search on the present claims, in conjunction with the previously issued non-final and final office actions. The present patent application was already the subject of an appeal, and the Examiner decided to withdraw the appeal to issue this restriction requirement.

In doing so, the Examiner has “placed the cart before the horse.” That is, the Examiner cannot *now* argue that each Group requires a separate field of search, which would be burdensome to the Examiner, because the Examiner has *already* performed a search on all the claims encompassed by all three identified Groups. The proper time for issuing a restriction requirement has long passed. The Examiner could have issued a restriction requirement as to the

originally presented claims; he did not, but rather performed a search as to *all* the claims, and presented a non-final office action rejecting the claims. The Examiner could have also issued a restriction requirement as to the claims as amended in the non-final office action response; he did not, but rather again performed a search as to *all* the claims, and presented a final office action rejecting the claims. In response to that final office action, Applicant filed a notice of appeal, and submitted an appeal brief arguing the rejections of the claims.

Therefore, the Examiner had ample opportunity to issue a restriction requirement, but in both situations – before issuing the non-final office action and before issuing the final office action – the Examiner chose not to do so, but instead decided to perform a search and issue rejections of the claims. As such, issuing a restriction requirement now is *wholly improper*. To say *now* that each Group requires a separate field of search, which would be burdensome to the Examiner, is to ignore the fact that *the Examiner has already performed a search on the all the claims encompassed by all three identified Groups*. There can be no further burden on the Examiner, because the Examiner has already performed a search. Applicant has not amended the claims between the time that the final rejection was issued and the time now that the restriction requirement was issued. As such, there is no need for the Examiner to perform another search – *he already has performed one, apparently without any prior burden!*

That is to say, it is disingenuous for the Examiner to have previously performed a search and examined the claims in light of the previous office action response, and only after considering Applicant's Appeal Brief decide that he should have performed a "better" search. The purpose of a restriction requirement is to prevent the Examiner from being burdened by performing multiple searches, as noted above. The purpose of a restriction requirement is not to allow the Examiner an "easier time" to perform a supplemental search when it is clear that his prior search was inadequate – especially after Applicant has filed an Appeal Brief. In other words, it is disingenuous and improper for the Examiner to burden Applicant with a restriction requirement, when throughout prosecution up to this point the Examiner did not find the claims – which have

not been amended since the non-final office action response – unduly onerous or burdensome to search.

The Examiner's restriction requirement is therefore improper because it is untimely. The purpose of a restriction requirement is to prevent the Examiner from being burdened by having to perform searches in multiples fields of search. However, insofar as the Examiner has *already examined* the claims as they are now pending, this means that the Examiner has *already performed a search* as to these claims. A restriction requirement, in other words, cannot alleviate the Examiner from the burden of performing searches in multiples fields *if the Examiner already has performed these searches!*

Applicant is reminded of the traveler who drives across the country to meet a friend. When meeting his friend, the traveler asks "Can you give me money to pay for gas when I drive across the country to visit you?" The friend looks quizzically at this traveler, and responds by noting "But you are *already here* and have *already* traveled across the country – presumably you *already* paid for the gas!" Likewise, in the present situation, the Examiner cannot say "I am issuing a restriction requirement so that I am not burdened in performing a search" after the Examiner has already performed the search. The deed has been done. It cannot be undone. Once a search has been made on claims, the Examiner cannot "go back" and say that it would be burdensome to do a search. The restriction requirement is simply improper.

Second reason why restriction requirement is improper

Even if the restriction requirement were timely, the substantive aspects of the restriction requirement are defective, rendering the requirement as a whole improper for a wholly different reason. In particular, the Examiner has stated that Groups I-III are related as subcombinations disclosed as usable together in a single combination, the single combination being a printhead, where the subcombinations are distinct from each other if they are shown to be separately usable

(restriction requirement, p. 3, para. 4). However, even cursory analysis of Groups I-III shows that they are not subcombinations usable in a single combination.

Consider first Group I as compared to Group III. Group I is, as exemplified by claim 1, directed to “a driver circuit for driving simultaneously a variable number of firing resistors for a printhead.” Almost identically, Group III, as exemplified by claim 20, is directed to “a driver circuit for firing simultaneously a variable number of firing resistors for associated nozzles in a printhead.” Therefore, Groups I and III are not subcombinations that can be used together in a single combination like a printhead. If the invention of Group I is used as the driver circuit in a printhead, then the invention of Group III cannot be used as the driver circuit in a printhead. That is, *both* Groups I and III are directed to a driver circuit. As such, they definitely cannot be “usable together in a single combination” like a printhead, as the Examiner suggests. Either you use the driver circuit of Group I in the printhead, or you use the driver circuit of Group III in the printhead; you do not *together* use the driver circuits of Groups I and III in the printhead.

Therefore, Groups I and III are not directed to subcombinations that can be usable in a single combination like a printhead. The Examiner is confusing what subcombinations are. Consider this example for illustration. You have a car as your combination. The car has various subcombinations: the suspension system, the engine, and so on. The suspension system of the car is one subcombination, which can be utilized with another subcombination – the engine – within a single combination like a car. However, this is not how Groups I and III are related. Rather, in our example, Group I is related to a suspension system, and Group III is also related to a suspension system, and both subcombinations – two suspension systems – cannot be used within a single combination like a car. Two driver circuits analogously are not subcombinations that can be *together* used within the same combination, like a printhead. Therefore, the restriction between Groups I and III is improper.

Consider next Group I or Group III as compared to Group II. Group I or Group III (identified hereafter as Group I/III) is a driver circuit subcombination that can be part of a single

combination like a printhead. However, Group II, as exemplified by claim 11, is directed to “a *method* for driving an inkjet printhead.” Applicant submits that a method can never be considered as a “subcombination” that can be part of a single combination like printhead. That is, it does not make sense to call a method a subcombination of an apparatus. Methods are a completely different statutory class of subject matter than apparatuses are, and thus cannot be considered any type of subcombination akin to an apparatus subcombination (like that of Group I/III) that can be part of a single apparatus combination like a printhead.

Therefore, Groups I/III and II are not directed to subcombinations that can be usable in a single combination like a printhead – indeed, a method cannot be part of an apparatus. The Examiner is confusing again what subcombinations are. Consider this example for illustration. You have a car as one combination, and a process for driving the car as another combination. The car has various subcombinations, as before: the suspension system, the engine, and so on. The process for driving the car also has various subcombinations: the process for operating the suspension system, the process for operating the engine, and so on. However, each subcombination of the car combination is not a subcombination of the process combination. That is, the suspension system is not a subcombination of the process combination, and the process for operating the suspension system is not a subcombination of the car combination.

Likewise, Groups I/III and II are not directed to subcombinations that are usable in the same combination. Group I/III is usable in a printhead, but Group II, which is directed to a method or process subcombination, is not usable in a printhead. No different than a process for operating a suspension system is not a subcombination of a car, a method of using a driver circuit is not a subcombination of a printhead. A method, in other words, quite simply cannot be a subcombination of an apparatus. Therefore, the restriction between Groups I/III and II is also improper.

Conclusion and provisional election

For the foregoing reasons, Applicant hereby traverses the restriction requirement. Applicant reminds the Examiner that the restriction requirement is wholly improper, both due to being untimely and due to being substantively defective, and Applicant is very much prepared to petition the Director should this burdensome restriction requirement not be withdrawn. However, only because Applicant is required to do so, and not in admission of the propriety of the restriction requirement (which Applicant strongly contests), Applicant hereby provisionally elects Group I, encompassing claims 1-7 and 13-19, for immediate examination.

Respectfully Submitted,



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